



AF IAW
2622

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPLICANT:	Karres, Ellia	
SERIAL NO.:	09/557,037	ART UNIT: 2622
FILED:	April 21, 2000	EXAMINER: Lamb, T.M.
FOR:	A System for Sequestering Print Advertisements and Displaying the Advertisements on an Electronic Medium	

To: Commissioner for Patents
Post Office Box 1450
Alexandria, Virginia 22313-1450

APPELLANT'S BRIEF (37 CFR § 41.37)

This Brief is filed in support of the Notice of Appeal filed on September 30, 2004, appealing the Examiner's decision of making final a rejection of claims 1-9.

12/06/2004 HALI11 00000030 09557037

01 FC:2402

170.00 OP



REAL PARTY IN INTEREST

The real party in interest in this appeal is the appellant named in the caption of the brief.

RELATED APPEALS AND INTERFERENCES

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal, there are no such appeals or interferences.

STATUS OF CLAIMS

A. TOTAL NUMBER OF CLAIMS IN APPLICATION - Nine (9)

Claims in the application: 1-9.

B. STATUS OF ALL THE CLAIMS

1. Claims canceled: None
2. Claims withdrawn from consideration but not canceled: None.
3. Claims pending: 1-9.
4. Claims allowed: None.
5. Claims rejected: 1-9.

C. CLAIMS ON APPEAL

The claims on appeal are: 1-9.

STATUS OF AMENDMENTS

No amendments were filed subsequent to the final rejection mailed on March 24, 2004.

SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1 is directed to a system for the display of advertisements over two communication mediums comprising: sequester means to sequester advertisements existing in a first format into a second format; display means to display said second format; and refresh means to update the second format when advertising information reflected in the first format changes; wherein said refresh means also maintains commonality in the advertisement between said first format and said second format where there are no changes. Spec., pp. 2-3; p. 9, ll. 6-10; p. 11; and p. 18, l. 3 - p. 20, l. 15.

Independent claim 2 is directed to a process for the display of an advertisement over two separate communication mediums comprising: sequestering advertisements existing in a first newspaper format into a second internet format; displaying the second format on the internet; refreshing the second format when advertising information reflected in the first format changes; and wherein refreshing also maintains commonality in the advertisement between the first format and the second format. Spec., pp. 2-3; p. 9, ll. 6-10; p. 11; and p. 18, l. 3 - p. 20, l. 15.

Independent claim 3 is directed to a system for displaying an advertisement in two distinct communication forms comprising: an editor means for first formulating the advertisement on a tangible medium; a printing means for initially producing the advertisement onto a paper medium; a file transfer means to transfer

the advertisement from said editor means to a universal remote locator; and a means to permit access to said universal remote location to view the advertisement from a visual display unit until said advertisement is replaced with a more current advertisement generated from said editor means. Spec., pp. 2-3; p. 9, ll. 6-10; p. 11; p. 14, l. 5 - p.17, l. 2; and p. 18, l. 3 - p. 20, l. 15.

Independent claim 4 is directed to a process for displaying an advertisement on a wide area computer network comprising: formulating an advertisement for a product or service; initially displaying the advertisement in a printed periodical; transferring an electronic identical copy of said advertisement to a universal resource locator; and permitting access to the advertisement at the universal resource location. Spec., pp. 2-3; p. 9, ll. 6-10; p. 11; p. 14, l. 5 - p.17, l. 2; and p. 18, l. 3 - p. 20, l. 15.

Claim 5 depends from claim 4 and further includes the step of: replacing the electronically displayed advertisement with a more recently formulated advertisement to maintain commonality between the most recent printed advertisement and the electronic advertisement. Spec., pp. 2-3; p. 9, ll. 6-10; p. 11; p. 14, l. 5 - p.17, l. 2; and p. 18, l. 3 - p. 20, l. 15.

Independent claim 6 is directed to a system for the display of newspaper advertisements on the internet comprising: means to convert advertisements from a newspaper format into an internet format; display means to display said internet format; and means to modify the internet format when information pertaining to

the contents of the newspaper advertisement changes. Spec., pp. 2-3; p. 9, ll. 6-10; p. 11; p. 14, l. 5 - p.17, l. 2; and p. 18, l. 3 - p. 20, l. 15.

Independent claim 7 is directed to a system for displaying an advertisement in a periodical and the internet comprising: an editor means for formulating the advertisement on a tangible medium; a printing means for producing the advertisement in the periodical; a file transfer means to transfer the advertisement from said editor means to a universal remote locator; and a means to permit access to said universal remote location to view the advertisement from a visual display until said advertisement is replaced with a more current advertisement generated from said editor means. Spec., pp. 2-3; p. 9, ll. 6-10; p. 11; p. 14, l. 5 - p.17, l. 2; and p. 18, l. 3 - p. 20, l. 15.

Independent claim 8 is directed to a process for displaying an advertisement on a wide area computer network comprising: formulating an advertisement for a product or service; displaying the advertisement in a printed periodical; fractionating the advertisement into data fields; transferring an electronic identical copy of said advertisement along with the data fields to a universal resource locator; and permitting access to the advertisement at the universal resource location. Spec., pp. 2-3; p. 9, ll. 6-10; p. 11; and p. 14, l. 5 - p. 21, l. 19.

Claim 9 depends from claim 8 and further includes the step of: allowing searching for the electronically displayed advertisement by the data fields by

presenting a query field to the user. Spec., pp. 2-3; p. 9, ll. 6-10; p. 11; and p. 14, l. 5 - p. 21, l. 19.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-2 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Angles et al. (US 5,933,811).

2. Claims 3-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Angles et al. in view of Dedrick (US 5,604,542).

3. Claims 6-9 are not directly addressed in the Examiner's final rejection, but appear to also be rejected under 35 U.S.C. § 103(a) as being unpatentable over Angles et al. in view of Dedrick (US 5,604,542).

ARGUMENTS

(a) Claims 1-2

Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Angles et al. (Angles) (US 5,933,811).

Examiner's position

With regard to claims 1 and 2, Angles discloses a system (Figure 1) for the display of advertisements over two communication mediums (col. 7, line 45 – col. 8 line 7) comprising: sequester means (consumer computer 12) to sequester advertisements in a first format into a second format (col. 18, line 61 – col. 19, line 3); display means (consumer computer) to display said second format (col. 19, lines 1-3); and refresh means (consumer computer 12 containing the "cookie") to refresh the second format when the first format changes; wherein said first format and said second format (col. 11, lines 2-49; col. 19, lines 28-49).

Applicant's position

Angles merely provides peripheral "custom ads" (abstract) mandated by a consumer profile generated by a consumer's other web requests (Fig. 3). In contrast, applicant's ads are the very subject of the web request.

The Angles patent is based upon the premise that a profile of a web user and/or shopper is developed based upon visits to certain web pages or the result of

web searches/inquiries. Based upon the profile that is created and stored in some central database, customized advertisements are then directed to that web user/shopper for his/her review and perusal. This is done whether the web user/shopper asks for the advertising or not. Along those lines, the 'pusher' of such advertising collects, amasses and modifies the user's profile over time based upon a cookie system so that the ads become more specialized.

With respect to rejections under 35 U.S.C. § 102, the Examiner is invited to consider the following binding, compelling precedent articulated by the Court of Appeals for the Federal Circuit:

". . . anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference." *Akzo N.V. v. United States ITC*, 808 F.2d 1471, 1 U.S.P.Q.2d 1241 (Fed. Cir. 1986).

Further, "those elements must either be inherent or disclosed expressly" *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 2 U.S.P.Q.2d 1051 (Fed. Cir. 1987).

". . . and must be arranged as in the claim[s] . . ." *Carella v. Starlight Archery & Pro Line Co.*, 804 F.2d 135, 231 U.S.P.Q. 644 (Fed. Cir. 1986).

In addition, ". . . [the] absence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 U.S.P.Q. 81 (Fed. Cir. 1986).

Claim 1

With regard to claim 1, anticipation does not lie because, inter alia, nowhere in Angles is there a teaching of taking an advertisement already existing in a first format (e.g., newsprint) and sequestering it into a second format (e.g., electronic) and subsequently updating the second format only when the content of the first format no longer is accurate. For example, a car dealer's advertisement may offer a special value on one specific automobile. When that car has sold, the information needs to change.

Angles has nothing in common with this claim and certainly does not anticipate it. Angles requires both particularized consumer information and particularized advertiser information so that an intermediary content provider can facilitate bi-directional flow of information (col. 3, lines 18-64). There is no "updating the second format" in Angles, as is required by claim 1.

Claim 2

Claim 2 diverges even more starkly from Angles. Nowhere does Angles concern itself, inter alia, with newspaper and its format; refreshing the internet version when the underlying information changes and maintaining commonality in the ad as to both the newspaper and internet formats. This might be the case, for example, when subsequent editions of the newspaper have an ad which has been modified compared to an earlier edition.

The Examiner believes Angles' "cookie" teaching anticipates applicant's "refreshing" requirements of claim 2. Angles nowhere makes a teaching comporting with the Examiner's assertion. Instead, the cookie "is useful for having the browser remember some specific information across several pages" (col. 11, lines 7-9). This is the conventional meaning.

(b) Claims 3-5

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles et al. (Angles (US 5,933,811) in view of Dedrick (US 5,604,542).

Examiner's position

With regard to claims 3 and 4, Angles discloses a system (Figure 1) for displaying an advertisement in two distinct communication (col. 7, line 45 – col. 8, line 7) comprising: an editor means (consumer computer 12) for formulating the advertisement on a tangible medium (col. 18, line 61 – col. 19, line 3); a file transfer means (content provider computer 14) to transfer the advertisement from said editor means to a universal remote locator (col. 19, lines 22-27); and a means (consumer computer 12) to permit access to said universal remote location to view the advertisement from a visual display unit until said advertisement is replaced with a more current advertisement generated from said editor means (col. 19, lines 1-3).

Angles differs from claims 3 and 4 in that he does not teach a printing means for producing the advertisement in a paper medium. Dedrick discloses a system for transmitting an electronic advertisement that includes a printing means (printer 94) for producing the advertisement in a paper medium (col. 3, lines 40-41).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Angles to include a printing means for producing the advertisement in a paper medium as taught by Dedrick. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified by the teaching of Dedrick so that the advertisement could be printed out as taught by Dedrick in col. 3, lines 40-41.

With regard to claim 5, Angles does not teach further including the step of: replacing the electronically displayed advertisement with a more recently formulated advertisement for commonality between the printed advertisement and the electronic advertisement.

Dedrick discloses a system for transmitting an electronic advertisement that includes further including the step of: replacing the electronically displayed advertisement with a more recently formulated advertisement for commonality between the printed advertisement and the electronic advertisement (which reads on the decoder, server and computer removing the advertisement from the video signal) (col. 3, lines 38-45).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Angles to include replacing the electronically displayed advertisement with a more recently formulated advertisement for commonality between the printed advertisement and the electronic advertisement as taught by Dedrick. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified by the teaching of Dedrick so that the advertisement could be printed out as taught by Dedrick in col. 3, lines 40-41.

Applicant's Position

The Examiner dismisses claims 3-5 with the inclusion of Dedrick, based on the premise that Dedrick is properly combinable with Angles and that its inclusion rectifies the only shortcoming in Angles – that of printing the ad.

The Examiner's position is legally incorrect. There is no motivation to combine these two patents. Dedrick converts an analog video broadcast into digital format and monitors the vertical blanking interval of the analog broadcast to insert an advertisement into that interval. The recipient can then print the inserted ad.

Angles' patent is for the delivery of custom advertisements based on consumer profiles. This type of target advertisement is heavily dependent upon people willing to provide information on their buying habits. A majority of people are unwilling to provide such information to "on-line" market research because of

issues of privacy. Therefore, this type of advertising has seen little usage by “e-commerce”. The instant invention does not need consumer profiles in order to provide information to a particular audience. The advertisements present on-line are identical, and thus readily identifiable to the particular public segment, to what the advertisers’ advertisement looks like in the newspaper. Further, the on-line advertisement extends the shelf-life of the advertisement because it is presented to the target audience for the entire week instead of one day, as an example.

Dedrick merely causes an electronic ad to be carried on a video signal where there contains no information (vertical blanking interval). Subsequently, an end user can print the ad.

The Dedrick patent is similar to Angles to the extent that it too uses demographic information that it gathers or accumulates on the web to target its advertising to those people. Dedrick then merely prints out the advertisement from the computer. This is not the same as a newspaper.

It is Black Letter Law the Patent and Trademark Office’s burden is to establish a prima facie case of obviousness. The Patent and Trademark Office has met its burden only when it fully describes:

“1) What the reference discloses, teaches and suggests to one skilled in the art; 2) What the reference lacks in disclosing, teaching or suggesting vis-à-vis the claimed features; 3) What particular teaching or suggestion is being relied upon either via a reference itself or knowledge of person of ordinary skill in the art; 4) A statement explaining the proposed modification in order to establish the prima facie case of obviousness; and finally 5) the motivation behind the

statement of obviousness which comes from three sources: a) teachings of the prior art; b) nature of the problem to be solved; or c) knowledge of persons of ordinary skill in the art”, see *In re Rouffet* 47 USPQ2d 1453 (Fed. Cir. 1998).

The Examiner has failed to meet these threshold requirements to establish prima facie obviousness. In the absence of such a prima facie showing, the Examiner’s rejection cannot stand:

“Decision rejecting claims in utility application as obvious over combination of prior art references must be reversed, since obviousness analysis in decision is limited to discussion of ways that multiple references can be combined to read on claimed invention, but does not particularly identify any suggestion, teaching, or motivation to combine references, and does not include specific or inferential findings concerning identification of relevant art, level of ordinary skill in art, nature of problem to be solved, or any other factual findings that might support proper obviousness analysis.” *In re Dembiczak*, 50 U.S.P.Q.2d 1614. [Emphasis added.]

Claim 3

Claim 3 first requires printing the ad prior to its transfer to a universal remote location. Neither Angles nor Dedrick teaches this.

Claims 4-5

Neither Angles nor Dedrick teaches the requirements of claim 4 of displaying the ad in a printed periodical prior to electronic transfer and access. Further, neither Angles nor Dedrick teaches the requirement of claim 5 wherein the electronic ad is replaced by an electronic version of a most recent printed version.

(c) Claims 6-9

In the final rejection, the Examiner dismisses claims 6-9 without analysis, remarking only that “The limitations for claims 6-9 are addressed above”.

Applicant’s position

Applicant’s position with respect to Angles et al. and Dedrick with respect to 35 U.S.C. § 103 are noted hereinabove. Angles and Dedrick simply do not address the conversion of advertisements in newspaper format to internet format and their subsequent modification.

Claim 6

As for claim 6, nowhere does the Examiner point to a teaching where a newspaper ad is converted into an internet format and is modified to remain current.

Claim 7

As to claim 7, no prior art has been applied which teaches an editor for formulating the ad in tangible form, a printer for producing the ad in a periodical

and subsequent transfer of the ad into a universal resource locator until the ad changes.

Claims 8-9

With particular attention to the subject matter of claims 8-9, the prior art simply broadcasts advertisements to a consumer based on information gathered by an advertiser. The advertiser chooses the advertisements that are broadcast, not the consumer.

As to claim 8, no prior art as been applied which teaches formulating an ad and displaying the ad in printed periodical, fractionating the ad into data fields and transfer to a URL. Similarly, claim 9 requires searching the data fields of claim 8 as a function of presenting a query field to the user.

Specifically, the prior art does not allow user discrimination in ad searching. The user receives what is broadcast, not what is desired.

CONCLUSION

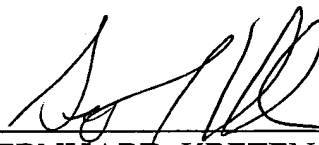
In view of the foregoing, it is respectfully requested that the Examiner's final rejection be vacated, the rejections tendered by the Examiner be reversed and this case be passed to issue. Such action is respectfully requested.

APPENDIX OF THE CLAIMS ON APPEAL

An appendix containing a copy of the claims involved in this appeal is attached.

Dated: November 30, 2004

Respectfully Submitted:

A handwritten signature in black ink, appearing to read 'B. Kreten', is written over a horizontal line.

BERNHARD KRETEN
Appellant's Attorney
Telephone (916) 930-9700
Registration No.: 27,037

APPENDIX: CLAIMS ON APPEAL

1. A system for the display of advertisements over two communication mediums comprising:

sequester means to sequester advertisements existing in a first format into a second format;

display means to display said second format; and

refresh means to update the second format when advertising information reflected in the first format changes;

wherein said refresh means also maintains commonality in the advertisement between said first format and said second format where there are no changes.

2. A process for the display of an advertisement over two separate communication mediums comprising:

sequestering advertisements existing in a first newspaper format into a second internet format;

displaying the second format on the internet;

refreshing the second format when advertising information reflected in the first format changes; and

wherein refreshing also maintains commonality in the advertisement between the first format and the second format.

3. A system for displaying an advertisement in two distinct communication forms comprising:

an editor means for first formulating the advertisement on a tangible medium;

a printing means for initially producing the advertisement onto a paper medium;

a file transfer means to transfer the advertisement from said editor means to a universal remote locator; and

a means to permit access to said universal remote location to view the advertisement from a visual display unit until said advertisement is replaced with a more current advertisement generated from said editor means.

4. A process for displaying an advertisement on a wide area computer network comprising:

formulating an advertisement for a product or service;

initially displaying the advertisement in a printed periodical;

transferring an electronic identical copy of said advertisement to a universal resource locator; and

permitting access to the advertisement at the universal resource location.

5. The process of claim 4 further including the step of:

replacing the electronically displayed advertisement with a more recently formulated advertisement to maintain commonality between the most recent printed advertisement and the electronic advertisement.

6. A system for the display of newspaper advertisements on the internet comprising:

means to convert advertisements from a newspaper format into an internet format;

display means to display said internet format; and

means to modify the internet format when information pertaining to the contents of the newspaper advertisement changes.

7. A system for displaying an advertisement in a periodical and the internet comprising:

an editor means for formulating the advertisement on a tangible medium;

a printing means for producing the advertisement in the periodical;

a file transfer means to transfer the advertisement from said editor means to a universal remote locator; and

a means to permit access to said universal remote location to view the advertisement from a visual display until said advertisement is replaced with a more current advertisement generated from said editor means.

8. A process for displaying an advertisement on a wide area computer network comprising:

- formulating an advertisement for a product or service;
- displaying the advertisement in a printed periodical;
- fractionating the advertisement into data fields;
- transferring an electronic identical copy of said advertisement along with the data fields to a universal resource locator; and
- permitting access to the advertisement at the universal resource location.

9. The process of claim 8 further including the step of:

- allowing searching for the electronically displayed advertisement by the data fields by presenting a query field to the user.